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**APR 07 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Watanabe	:	DECISION
Application No. 10/753,338	:	
Filing Date: 9 January, 2004	:	
Attorney Docket No.: 246924US3 DIV	:	

This is a decision on the petition filed on 27 March, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

**BACKGROUND**

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the final Office action mailed on 27 January, 2005, with reply due absent and extension of time on or before 27 April, 2005;
- while Petitioner filed on 27 April, 2005, an after-final amendment, the Examiner found it not to be a proper reply (in that it did not *prima facie* place the application in condition for allowance<sup>1</sup>), and mailed an Advisory Action on 15 May, 2005;

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<sup>1</sup> A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or RCE (with fee and submission). (See: MPEP §711.03(c).)

- the application went abandoned after midnight 27 April, 2005;
- when it appeared further that Petitioner had not replied timely and properly following the Advisory action, the Office mailed the Notice of Abandonment on 26 January, 2006;
- on Monday, 27 March, 2006, Petitioner filed the instant petition with the allegation that a proper and timely reply had been filed on 27 May, 2005 (with the request and fee for a one- (1) month extension of time), in the form of a request for continued examination (RCE) with fee<sup>2</sup> and submission in the form of an amendment (along with what are averred to be true copies of same), and Petitioner supports that allegation with what is averred to be a true copy of a date-stamped date-stamped ("MAY 27 2005") receipt card evidencing receipt by the Office of the timely reply.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>3</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>4</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>5</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>6</sup>

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<sup>2</sup> While the substantive papers are not in evidence, the Office record reflects payment of the RCE and extension fees.

<sup>3</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>4</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>5</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>6</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.<sup>7</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>8</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>9</sup>

It appears that Petitioner has satisfied the requirements of the regulation and the case law as discussed above.

CONCLUSION

Because Petitioner has satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **granted**, fees are waived and none have been charged; and the Notice of Abandonment of 26 January, 2006, hereby is **vacated**.

**The instant matter is released to Technology Center 3600 for further processing in due course.**

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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Senior Attorney  
Office of Petitions

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<sup>7</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>8</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>9</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).